

## **REMARKS**

In the outstanding Office Communication, the Examiner deemed the previously filed Amendment dated January 31, 2005 non-responsive because it cancelled all claims drawn to the elected invention. However, the Examiner remarked that the previous Amendment was a bona fide attempt to reply to the outstanding Office Action dated November 1, 2004 ("Office Action") and allowed extensions of time under 37 C.F.R. § 1.136(a). In response, Applicant adds new claims 52-67 which are similar to, but not the same as, cancelled claims 1-35. New claims 52-67 are drawn to the elected invention because the new claims, for example, include product claims drawn to a molding die.

In order to provide a complete response, Applicant will address the previous rejections made in the outstanding Office Action as applied to new claims 52-67. Claims 36-67 are pending and under consideration.

### **Rejections under 35 U.S.C. §§ 102(b), 103(a)**

In the Office Action the Examiner rejected the now cancelled claims 1 and 3-21 under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Japanese Patent Application Publication No. JP 10-217257 to Akihisa et al. ("Akihisa"). Office Action at pages 2-4.

As mentioned above, Applicant adds new claims 52-67 that are directed to a molding die. Support for new claim 52 can be found at, for example, pages 13-14 of the specification. For the sake of a complete response, Applicant distinguishes Akihisa from new claim 52.

Claim 52 recites, in part, “[a] molding die for molding an optical element, comprising . . . a die face corresponding to an optical surface of the optical element formed by shaving a part of the die base body through the use of a processing machine, wherein the processing machine is attached to the die base body on the basis of the reference surface.” Applicant respectfully asserts that Akihisa does not teach or suggest this.

For example, Akihisa discloses a metal mold that creates a cavity section (e.g., “8”, Fig. 2c) within two amorphous alloy blocks (e.g., “1a”, “1b”, and “1c”, Figs. 2a-2c). Akihisa goes on to teach that the cavity section is then used as a mold to produce molded objects from the blocks. However, in contrast to claim 52, nowhere does Akihisa teach or suggest optical elements, optical surfaces, or optics *at all*. Thus, Akihisa cannot be said to teach or suggest “a die face corresponding to an optical surface of the optical element . . .,” as recited by claim 52.

In addition, Akihisa does not teach or suggest “wherein the processing machine is attached to the die base body on the basis of the reference surface.” At best, with reference to Figs. 1 and 2a-2c, Akihisa discloses that cavity section “8” can be manufactured, in part, by machining, or processing, blocks “1a” and “1b.” See, e.g., paragraph [0031]. However, Akihisa does not teach or suggest that the processing machine (used, e.g., to machine blocks “1a” and “1b”) is attached to the die base body on the basis of the reference surface, as recited by claim 52.

As such, for at least the reasons given above, Applicant submits that Akihisa does not teach or suggest each and every element of claim 52. Therefore, Applicant respectfully asserts that claim 52 is patentable over Akihisa. Claims 53-67 all directly or

indirectly depend from claim 52. Thus, these claims are also patentable over Akihisa for at least the same reasons discussed above for claim 52.

### **Provisional Obviousness-Type Double Patenting Rejection**

The Examiner provisionally rejected now cancelled claims 1-8 and 19-21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 8 of copending Application No. 10/079,496. In addition, the Examiner provisionally rejected now cancelled claims 17-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 8 of copending Application No. 10/079,496 in view of Akihisa. Initially, Applicant thanks the Examiner for pointing out these potential rejections. Without acquiescing to the Examiner's provisional rejections, Applicant submits that, given at least the reasons stated above, these provisional rejections, if applied to new claims 52-67, would be the only remaining rejections in this matter. Thus, "the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent." MPEP 804(I)(B). Applicant will again address this potential issue once the claims in either application are in condition for allowance.

Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extension of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: July 25, 2005

By: \_\_\_\_\_

  
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Date: July 25, 2005

Signed: \_\_\_\_\_

  
Theresa M. Vargas